

#22

OFFICE OF PETITIONS

Customer Number 22,852

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

John EBY et al.

Group Art Unit: 1732

Application No.: 09/287,631

Examiner: A. Kuhns

Filed: April 7, 1999

For: SURFACE COVERINGS HAVING
A NATURAL APPEARANCE AND
METHODS TO MAKE A
SURFACE COVERING HAVING
A NATURAL APPEARANCE

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

INFORMATION DISCLOSURE STATEMENT UNDER 37 C.F.R. § 1.97(b)(4)

Pursuant to 37 C.F.R. §§ 1.56 and 1.97(b)(4), Applicants bring to the attention of the Examiner the following information. This Information Disclosure Statement is being filed concurrently with a request for continued examination under 37 C.F.R. § 1.114 and before the mailing date of a first Office Action on the merits for the above-referenced application.

A third party has presented Applicants with documentation and a product sample that they allege establishes an offer for sale or a sale of a vinyl flooring product by the third party more than one year before Applicants' filing date. The third party has asserted that the alleged offer for sale or sale invalidates the claims of U.S. Patent No. 6,114,008. The above-captioned application claims benefit under

LAW OFFICES

**FINNEGAN, HENDERSON,
FARABOW, GARRETT,
& DUNNER, L.L.P.**
1300 I STREET, N. W.
WASHINGTON, DC 20005
202-408-4000

35 U.S.C. § 120 from the same family of applications that gave rise to the 6,114,008 patent. Consequently, the third party's documentation and sample may be material or relevant to the patentability of the instant claims. However, the third party marked the documentation and sample "confidential" and has refused to allow Applicants to submit the documentation and sample to the U.S. Patent and Trademark Office. See letters attached at Tab 1. Nonetheless, for reasons explained below, it is Applicants' opinion that the documentation and sample fail to establish a *prima facie* case of anticipation or obviousness.

GRK
5-1-01

An analysis of the product allegedly offered for sale or sold by the third party reveals several important, and in Applicants' view patentable, distinctions between the claimed invention and the alleged product or the process assumed to be used to manufacture it. The product, as analyzed by the third party and confirmed by Applicants, comprises a felt layer (backing layer), a compact coat (likely a strengthening layer), a chemically embossed foam layer, a wear layer, and a urethane layer (top-coat), containing surface texture.

First, it is not apparent whether the third party used a mechanical embossing step on this product. Given the shallowness of the surface texturing on the urethane layer, it is possible that the texturing may be the result of a paper casting step rather than mechanical embossing.

Second, the third party's product was embossed/casted in the urethane layer (top-coat) and **not** the wear layer. This is evidenced by a number of factors. First, the texturing is described as being applied to an existing finished product that is known to have had a urethane top-coat. Second, the documentation refers to a

concern about a "crinkling" phenomenon associated with heating a urethane top-coat and not a vinyl wear layer. Third, the reported depth of the texturing is less than a quarter of the thickness of the top-coat layer, which is above the wear layer. Fourth, photomicrographs by Applicants of the sample do not show embossing in the thicker wear layer. Fifth, if the urethane layer had been added after surface texturing of the wear layer, the urethane would have filled in the texture thereby resulting in a smooth surface. That was not the case.

In summary, even assuming that the third party was able to establish a prior offer for sale or sale of the third party's product, the product does not teach or suggest mechanical embossing in the wear layer.

GRK
5-1-01

This submission does not represent that a search has been made or that no better art exists and does not constitute an admission that the disclosed information is material or constitutes "prior art." If the Examiner applies the information as prior art against any claim in the present application and Applicants determine that the information does not constitute "prior art" under United States law, Applicants reserve the right to present to the Patent Office the relevant facts and law regarding the appropriate status of such information.

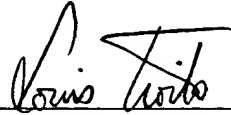
Applicants further reserve the right to take appropriate action to establish the patentability of the disclosed invention over the disclosed information, should it be applied against the claims of the present application.

If there is any fee due in connection with the filing of this Statement, please
charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 7, 2001

By: 
Louis M. Troilo
Reg. No. 45,284